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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,671	06/15/2001	Youichirou Sugino	04558/050001	9498

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WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP  
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WASHINGTON, DC 20036

EXAMINER

DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Cm

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/882,671	SUGINO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Tamra L. Dicus	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18, 21-35 and 42-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18, 21-35 and 42-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

The RCE is acknowledged.

#### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 22 is rejected under 35 U.S.C. 102(b) as being unpatentable over USPN 5,286,418 to Nakamura et al.

Nakamura teaches a single layer polarizer consisting of a hydrophobic polymer having a shrinkage ratio of no greater than 1% (Abstract and Example 2). Thus this teaching meets the recitation of a shrinkage force of at most 4.0 N/cm or from 1.0 to 3.7 N/cm of the polarizer alone per instant claim 22 (“insubstantial amount” meets “at most 4.0 N/cm”).

Claims 1-2, 5-6, 21-22, 35, and 42-49 are rejected under 35 U.S.C. 102(b) as being unpatentable over USPN 4,818,624 to Downey, Jr.

Downey teaches a polarizer comprising a stretched polyvinyl alcohol monolayer film alone and can further be laminated to a variety of supports including cellulose acetate or polyester such as polyethylene terephthalate (PET) via a polyvinyl alcohol (PVA) or polyurethane adhesive (col. 2, line 25-col. 3, line 11) per instant claims 1-2, 5, 22, 26, and 49.

The film thickness ranges from 0.038 to 0.051 mm (col. 2, lines 32-35), converted is 38-51

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microns, 20-50 microns, not more than 60 microns, not more than 75 microns, and at most 60 microns of instant claims 6, 42, 46, and 47.

Regarding the shrinkage factor, while Downey does not refer to a shrinkage factor per se, Downey does teach the single polarizer containing stretched PVA monolayer film should shrink slightly noting reduced shrinkage after subjecting the film to elevated temperatures 120 - 200 degrees F for 24 hours (col. 2, lines 25-35, col. 3, lines 48-59, col. 4, lines 15-22, and Table I). Thus this teaching meets the recitation of a shrinkage force of at most 4.0 N/cm or from 1.0 to 3.7 N/cm of the polarizer alone per instant claims 1, 2, and 22 ("insubstantial amount" meets "at most 4.0 N/cm"). The dimensional change rate of not more than  $\pm 0.7\%$  in a longitudinal direction (MD) after being heated at 70°C for 120 hours (instant claim 21), is inherent as the same material, and similar conditions are provided by Downey. Regarding claims 42-43, Hopper teaches dyeing the hydrophilic PVA film in a treating bath (water), stretching the film due to heating (swelling treatment), treating the film with a dye such as iodine, and curing with a silylation of PVA using silane and organosilane compounds, boric acid and fuming hydrochloric acid (crosslinking treatment and agent as Applicant's disclose on page 1, line 15 and page 17, line 26 of the specification), and drying the film (see col. 3, lines 15-39, col. 4, line 15-col. 5, line 20, col. 6, lines 25-60) (instant claims 42-43). To instant claim 48, a dye such as iodide is present (col. 3, lines 17-18). Regarding the claims to processes such as stretching, relaxing, and drying steps (claims 44-45), these are process limitations in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a

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product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,818,624 to Downey, Jr.

Downey essentially teaches the claimed invention as relied upon above. While Downey does teach the polarizer has a thickness from about 0.038 to about 0.051, converted is 38 to 51 microns, Downey does not teach the polarizer is thinner (at most 25 microns and 10-18 microns). However, it would have been obvious to one having ordinary skill in the art to produce a thinner polarizer using less material, thereby making a cost effective product.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,818,624 to Downey, Jr. in view of USPN 6,065,457 to Aminaka.

Downey essentially teaches the claimed invention as relied upon above.

Downey does not teach a PVA having a saponification degree of at least 75 mol% or the average polymerization degree from 500-10000 (instant claim 7).

Aminaka teaches optical layers in liquid crystal displays. Aminaka teaches using commercially available PVA having saponification degree of not smaller than 80%, which falls within Applicant's range, and a polymerization degree preferably of not smaller than 200, which is close within Applicant's recited range above. See col. 20, lines 5-12.

It would have been obvious to one having ordinary skill in the art to have modified the polarizer of Downey to include a PVA having the requirements recited because Aminaka teaches the specific PVA is a commercially available, serving as an equivalent, useful in polarizers for LCDs (see col. 20, lines 5-12) to align discotic compounds found in PVAs to assist in activation by electric or magnetic fields or light for orientation purposes or to aid in preparing an ellipsoidal polarizing plate (see col. 19, lines 35-col. 20, line 11 and col. 20, lines 22-23 of Aminaka).

Claims 8-16, 23-28, 42-47 and 50-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,818,624 to Downey, Jr. in view of USPN 6,065,457 to Aminaka.

Downey teaches a polarizer comprising a stretched polyvinyl alcohol monolayer film alone and can further be laminated to a variety of supports including cellulose acetate or polyester such as polyethylene terephthalate (PET) (polarizing plate) via a polyvinyl alcohol (PVA) or polyurethane adhesive (col. 2, line 25-col. 3, line 11) per instant claims 8, 13-14, 15, and 26. See also abstract. Regarding instant claims 24, 25, and 27, the film thickness ranges from 0.038 to 0.051 mm (col. 2, lines 32-35), converted is 38-51 microns, 20-50 microns, not more than 60 microns, not more than 75 microns, and at most 60 microns of instant claims.

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Further, while Downey does teach the polarizer has a thickness from about 0.038 to about 0.051, converted is 38 to 51 microns, Downey does not teach the polarizer is thinner (at most 25 microns and 10-18 microns). However, it would have been obvious to one having ordinary skill in the art to produce a thinner polarizer using less material, thereby making a cost effective product.

Regarding the shrinkage factor, while Downey does not refer to a shrinkage factor per se, Downey does teach the single polarizer containing stretched PVA film should shrink slightly noting reduced shrinkage after subjecting the film to elevated temperatures 120 - 200 degrees F for 24 hours (col. 2, lines 25-35, col. 3, lines 48-59, col. 4, lines 15-22, and Table I). Thus this teaching meets the recitation of a shrinkage force of at most 4.0 N/cm or from 1.0 to 3.7 N/cm of the polarizer alone per instant claims 1, 2, and 22 ("insubstantial amount" meets "at most 4.0 N/cm"). The dimensional change rate of not more than  $\pm 0.7\%$  in a longitudinal direction (MD) after being heated at 70°C for 120 hours (instant claim 16), is inherent as the same material, and similar conditions are provided by Downey. Regarding claims 35 and 50-51, Downey teaches dyeing the hydrophilic PVA film in a treating bath (water), stretching the film due to heating (swelling treatment), treating the film with a dye such as iodine, and curing with a silylation of PVA using silane and organosilane compounds, boric acid and fuming hydrochloric acid (crosslinking treatment and agent as Applicant's disclose on page 1, line 15 and page 17, line 26 of the specification), and drying the film (see col. 3, lines 15-39, col. 4, line 15-col. 5, line 20, col. 6, lines 25-60) (instant claims 42-43). To instant claim 48, a dye such as iodide is present (col. 3, lines 17-18). Regarding the claims to processes such as stretching, relaxing, and drying steps (claims 44-45), these are process limitations in a product claim. Product-by-process claims are

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not limited to the manipulations of the recited steps, only the structure implied by the steps.

Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531.

Both Applicant's and prior art reference's product are the same.

While Downey teaches using a cellulose acetate film laminated to the PVA polarizer film (col. 2, line 50), Downey does not teach a protective film or its composition of triacetylcellulose, laminated via an adhesive on the polarizer or the thickness of the protective film as instant claim 8-13 recite.

Aminaka teaches polarizers and optical films used in LCDs. Aminaka teaches a protective layer of triacetylcellulose laminated to a transparent polymer film of PVA via an adhesive layer forming an ellipsoidal polarizing plate. See col. 20, lines 40-col. 21, line 35. Aminaka teaches the thickness of the protective triacetylcellulose ranges from 20 to 500 microns (col. 20, line 63), falling within Applicant's claimed range of at least 80 microns, from 80 – 200 microns (instant claims 10-11).

It would have been obvious to one of ordinary skill in the art to have modified the film of Downey to further include a protective film/adhesive/polarizer in this order because Aminaka teaches such structure is useful in preparing an ellipsoidal polarizing plate improving a viewing angle of a LCD of bend alignment mode or homogenous alignment mode without causing color contamination on a displayed image (col. 3, lines 35-50 and col. 4, lines 53-59 of Aminaka). Further it is obvious to utilize the protective film because it is made of the same triacetylcellulose

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film and functions to serve as a protective layer and Aminaka teaches the material serves as a protective membrane for protecting the PVA film (col. 21, line 19-24). It would have been obvious to one of ordinary skill in the art to use an adhesive to adhere the protective and polarizing layers to result in a laminate for producing an ellipsoidal polarizing plate. Because the protective film thickness falls within the Applicant's range (taught by Aminaka above), and the polarizer thickness falls within Applicant's range, it would have been obvious to have modified the polarizer of Downey to satisfy the A/B relationship of instant claims 8-9, as they are conventional thicknesses used in an LCD as cited above.

Further, in regards to instant claim 14, while Downey teaches an adhesive of polyvinyl alcohol, Downey does not teach the adhesive that adheres a protective film and polarizer is of PVA. However, because Downey teaches a PVA-based adhesive is a suitable type of adhesive to adhere polarizers to substrates and Aminaka teaches the structure adhering PVA to a protective film, it would have been obvious to utilize a PVA-based adhesive as it serves to adhere two layers to provide a laminate as cited above.

Regarding claim 28, Downey does not teach a PVA having a saponification degree of at least 75 mol% or the average polymerization degree from 500-10000.

Aminaka teaches optical layers in liquid crystal displays. Aminaka teaches using commercially available PVA having saponification degree of not smaller than 80%, which falls within Applicant's range, and a polymerization degree preferably of not smaller than 200, which is close within Applicant's recited range above. See col. 20, lines 5-12.

It would have been obvious to one having ordinary skill in the art to have modified the polarizer of Downey to include a PVA having the requirements recited because Aminaka teaches

the specific PVA is a commercially available equivalent useful in polarizers for LCDs (see col. 20, lines 5-12) to align discotic compounds found in PVAs to assist in activation by electric or magnetic fields or light for orientation purposes or to aid in preparing an ellipsoidal polarizing plate (see col. 19, lines 35-col. 20, line 11 and col. 20, lines 22-23 of Aminaka).

Claims 17-18 and 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,818,624 to Downey, Jr. in view of USPN 6,065,457 to Aminaka and further in view of USPN 6,361,838 to Miyatake et al.

Downey in view of Aminaka is relied upon above to claim 8.

The combination does not teach further comprising an optical layer selected from a reflector, transreflector, retardation plate, lambda plate, a viewing angle compensating film, or a brightness enhancement plate of instant claims 17 and 29-34.

Miyatake teaches an optical film/member that may be used to produce a multilayer structure by providing optical layers on sides of a polarizing/retardation film that includes absorption types like hydrophilic polymer films of PVA that have been stretched. See col. 7, lines 39-65, and col. 8, lines 5-54. Such optical films, like those of instant claims 17 and 29-34 may be used to produce the following types of films: absorption type, reflection type, scattering type polarizers, retardation films including a quarter-wavelength plate, a half-wavelength plate, a retardation film comprising a uni- or biaxially or otherwise stretched film, a film comprising a film which has undergone inclined orientation, i.e., which has undergone molecular orientation also in the thickness direction, a film comprising a liquid crystal polymer, a film in which a retardation caused by a viewing angle or birefringence is compensated for, and a film comprising

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two or more of these retardation films superposed on each other. See col. 8, lines 1-54.

Miyatake teaches a polarizing film also includes a polarizing film comprising any of the above-described polarizing films and a transparent protective layer formed on one or each side thereof for the purpose of protection against water. Miyatake does not explicitly define the aforementioned functional films as “brightness-enhanced” or a “transflector”. The Examiner takes the position that the phrase “brightness-enhanced” is a functional equivalent of the optical film of Miyatake at col. 7, lines 38-51 since the optical film that functions to improve perceptibility and bright displays as taught by Miyatake at col. 6, lines 50-60. The Examiner also takes the position that “transflector” is synonymous to an optical layer that reflects or scatters light as taught above in the aforementioned film types.

Thus, it would have been obvious to one having ordinary skill in the art to have modified the combination of Downey in view of Aminaka because Miyatake teaches an optical layer selected from a reflector, transreflector, retardation plate, lambda plate, a viewing angle compensating film, and a brightness enhancement plate for various functions as explained above for light scattering properties, protection against water, to improve perceptibility and bright displays used in multilayered polarizers in an LCD (col. 8, lines 1-66, col. 9, lines 1-36 and col. 11, lines 32-40 of Miyatake).

Further to claim 18, the combination of Downey and Aminaka does not teach a polarizing plate laminated through an adhesive layer to an optical layer.

Miyatake teaches lamination of said polarizing plate and optical layer via an adhesive in Example 2 for the purpose of adhering the two layers thus forming a multilayered laminate

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polarizer used in LCDs. Further adhesives layers are present in a laminate as shown by all cited prior art above.

Thus it would have been obvious to one having ordinary skill in the art to have modified the combination to include an adhesive layer laminating a polarizing plate and optical layer because the cited prior art teaches adhesive layers are used to adhere additional layers for the purposes of forming a multilayered optical element used in LCDs and Miyatake teaches an adhesive layer in Example 2 for laminating optical layers.

### *Response to Arguments*

Applicant's arguments are not found persuasive. Applicant submitted a declaration, however, the declaration measures shrinkage force at a temperature of 105 degrees C, which is not the claimed temperature at 80 degrees C, nor in the range of Downey (48.9-98.9 degrees C). Thus, the data and tests found in the declaration are inconsistent. Further, the Declaration does not show or prove Nakamura's low shrinkage force. Applicant further argues that the declaration proves that the shrinkage force at thickness of 40 and 75 microns being 5 N/cm and 7 N/cm, respectively, is not the shrinkage force of "at most 4 N/m", however, because the data is inconsistent and lacks comparative data to ranges of times, temperatures, and thickness of the prior art and invention, it cannot be relied upon. Further, analyzing the chart, the shrinkage force (SF) appears to decrease with time, and thus is under 4 N/m when the time is approx. 20 min. or less. Nakamura dries the film for only 3 min. at 300 degrees, thus it would be understood that the SF would be "at most 4 N/m" especially since Nakamura teaches a shrinkage ratio no greater

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than 1% and no substantial reduction in the degree of polarization was noted and heated at the same 80 degrees C in Example 2, which would indeed meet the recitation "at most 4 N/m" as it is an insubstantial amount. The numeral 4 is the upper limit, and the way the claim is written, "at most 4" means that it can include lower values, such as zero, and "no greater than 1%", would be understood in the scope of the prior art to meet the claim. Because Applicant has not disproved the teachings of Nakamura, until the Applicant submits a convincing Declaration having sufficient comparative data, the rejection stands.

Applicant argues where shrinkage force is measured in Downy (e.g. shrinkage force measured on the polarizer itself not a lamination with a support sheet). Applicant's argument is not persuasive because Applicant's invention teaches the same single polarizer (1, FIG. 1 of instant drawing), laminated to various layers (2-5, FIG. 1). Thus, the same layer is taught, where the SF is measured does not change the structure.

Applicant argues Downey not being a monolayer film or consisting of a stretched hydrophilic film. However, Applicant's argument is not convincing because Downey teaches the same layer having the same dyed, stretched, PVA material.

Nakamura and Downey is still used to teach a polarizer alone in a single layer having the required shrinkage force. Aminaka is still used in the rejection to teach the PVA properties e.g. saponification degree and the protective film of triacetylcellulose. Miyatake is still relied upon to teach the various functionality films e.g. transflector, retardation, lambda.

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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

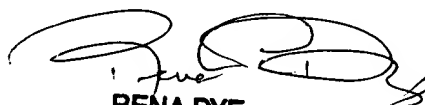
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamra L. Dicus  
Examiner  
Art Unit 1774

March 14, 2006



RENA DYE  
SUPERVISORY PATENT EXAMINER  
A.U. 1774 3/16/06